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7 UNITED STATES DISTRICT COURT
8 WESTERN DISTRICT OF WASHINGTON
9 AT SEATTLE

10 PACIFIC BIOSCIENCE
11 LABORATORIES, INC.,

CASE NO. C15-0689JLR

ORDER

12 Plaintiff,

13 v.

14 HOME SKINOVATIONS, INC., et
15 al.,

Defendants.

16 I. INTRODUCTION

17 On November 2, 2015, the court granted the parties' stipulated motion for the
18 entry of a permanent injunction and order of dismissal. (PI (Dkt. # 18).) The permanent
19 injunction restrained and enjoined Defendants Home Skinovations, Inc., and Home
20 Skinovations, Ltd. (collectively, "Home Skinovations") from infringing any of the claims
21 of United States Patent No. 7,320,691 ("the '691 Patent") with certain products in the
22 United States. (*Id.* at 2.) The court retained jurisdiction over the action. (*Id.*)

1 Two motions are before the court: (1) Home Skinovations's motion for
 2 clarification of the court's permanent injunction (MFC (Dkt. # 21)); and (2) Plaintiff
 3 Pacific Bioscience Laboratories, Inc.'s ("PBL") motion for leave to provide new
 4 information in support of its opposition and surreply to Home Skinovations's motion for
 5 clarification (MFL (Dkt. # 35)). The court has considered the motions, the parties'
 6 submissions filed in support of and opposition to the motions, the relevant portions of the
 7 record, and the applicable law.¹ Being fully advised,² the court DENIES Home
 8 Skinovations's motion and DENIES PBL's motion as moot.

9 II. BACKGROUND

10 On May 1, 2015, PBL filed suit alleging that Home Skinovations directly
 11 infringed the '691 Patent. (Compl. (Dkt. # 1).) On June 19, 2015, the International Trade
 12 Commission ("ITC") instituted Investigation No. 337-TA-959, *In the Matter of Certain*
 13 *Electric Skin Care Devices, Brushes and Chargers Therefore, and Kits Containing Same*.
 14 (Stay Ord. (Dkt. # 15) at 1.) On June 29, 2015, the court stayed PBL's lawsuit pursuant
 15 to 28 U.S.C. § 1659(a) pending the ITC's final determination in Investigation No.
 16 337-TA-959. (*See id.* at 2-3.)

17 On October 29, 2015, the parties filed a joint motion asking the court to enter a
 18 permanent injunction and order of dismissal with prejudice. (Joint Mot. for PI (Dkt.

19 ¹ PBL filed a surreply to Home Skinovations's motion seeking to strike certain portions
 20 of Home Skinovations's reply as new arguments or facts that should not have been initially
 21 raised in a reply memorandum. (*See Surreply* (Dkt. # 34).) The court denies PBL's request.

22 ² No party has request oral argument on either motion, and the court does not consider
 23 oral argument to be helpful to its disposition of the motions. *See Local Rules W.D. Wash. LCR*
 24 7(b)(4).

1 # 17).) The parties stipulated that the entry of the permanent injunction was without
2 admission by Home Skinovations of infringement, liability, or violation of the law, and
3 was solely to settle the dispute between the parties. (*Id.* at 2.) On November 2, 2015, the
4 court granted the joint motion and entered a permanent injunction and order of dismissal.
5 (See PI.)

6 The permanent injunction restrained and enjoined Home Skinovations from
7 “infringing, contributing to the infringement, or inducing the infringement, of any claims
8 of the ’691 Patent, including by making, using, offering to sell and/or selling in the
9 United States and/or importing into the United States an Accused Product or any other
10 product containing elements that are colorable imitations of an Accused Product.” (*Id.* at
11 2.) The permanent injunction defined “Accused Products” to mean:

12 [T]he Silk’n Sonic, the BellaSonicCleanPlus, replacement brush heads for
13 each, and substantially similar products sold or offered for sale in, or
14 imported into, the United States by Home Skinovations that infringe any
15 claims of . . . the ’691 Patent

16 (*Id.* at 1.) On June 8, 2016, Home Skinovations filed a sworn statement certifying
17 compliance with the permanent injunction. (Statement (Dkt. # 19).)

18 Following entry of the permanent injunction, Home Skinovations redesigned its
19 brush product, which it now calls the Silk’n Pure. (See MFC at 7-10.) The Silk’n Pure is
20 a unidirectional rotating cosmetics brush. (See *id.*) In its motion, Home Skinovations
21 seeks a determination from this court that (1) the Silk’n Pure’s unidirectional operation
22 does not satisfy the “bi-directional about a neutral position” claim limitation of the ’691
Patent, and (2) therefore, the redesigned Silk’n Pure brush is outside the scope of the

1 permanent injunction. (*See id.* at 12; MFC Reply (Dkt. # 32) at 2, 6.) Home
2 Skinovations states that it has repeatedly asked PBL to confirm that the Silk'n Pure is not
3 covered by the claims of the '691 Patent, but PBL has declined to respond. (MFC at 10.)

4 Home Skinovations has made conflicting representations to the court concerning
5 the commercial availability of the Silk'n Pure brush in the United States. In its motion,
6 Home Skinovations states that it has already introduced the Silk'n Pure into the Canadian
7 and European markets without objection by PBL and "is planning to imminently
8 introduce the product commercially into the U.S. market." (*Id.*) Home Skinovations
9 maintains, however, that it has only "imported a handful of samples of its redesigned
10 Silk'n Pure product to the U.S. for analysis by its counsel." (*Id.*) Despite the foregoing
11 representations, Home Skinovations submitted evidence with its reply memorandum that
12 the redesigned Silk'n Pure brush was already commercially available in the United States
13 at the time Home Skinovations filed its September 15, 2016, motion. (*See* MFC Reply at
14 3 (citing Bank Decl. (Dkt. # 32-1).) In its September 30, 2016, reply memorandum,
15 Home Skinovations states that Kohl's Corporation "issued a U.S. purchase order for the
16 Silk'n Pure product in August, 2016." (*Id.* (citing Bank Decl. ¶ 4).) Further, to fulfill the
17 order, "Home Skinovations ordered approximately 10,000 units of the Silk'n Pure brush
18 product from its overseas supplier on August 25, 2016." (*Id.* (citing Bank Decl. ¶ 6).)
19 Indeed, Home Skinovations declares in its reply memorandum that its "redesigned brush
20 product has already been imported into and is commercially available in the U.S.
21 market." (*Id.*) The court cannot reconcile Home Skinovations's representations in its
22 motion that it had imported "a handful of samples . . . for analysis by its counsel" and

1 was “planning to imminently introduce the product commercially in the U.S. market”
 2 (MFC at 10), with the representations in its reply memorandum that the product is
 3 already commercially available here (MFC Reply at 3).³

4 PBL argues that Home Skinovations is seeking an impermissible advisory opinion
 5 that its Silk’n Pure brush does not violate the ’691 Patent and that the issue of
 6 noninfringement is not properly before the court. (*See generally* MFC Resp. (Dkt. # 27).)
 7 The court now considers Home Skinovations’s motion.

8 **III. ANALYSIS**

9 A party “subject to an injunction always has the right to ask the court that is
 10 administering it whether it applies to conduct in which the person proposes to engage.”
 11 *Matter of Hendrix*, 986 F.2d 195, 200 (7th Cir. 1993). To the extent that such a motion
 12 for clarification “looks like a request for an ‘advisory opinion,’ it is one that even a
 13 federal court can grant.” *Id.* However, “[i]t is within the ‘sound discretion of the court’
 14 whether to grant such a clarification or modification of an injunction if a party ‘enter[s]
 15 upon transactions which raise doubts as to the applicability of the injunction.’”

16 *Cornucopia Prod., LLC v. Dyson, Inc.*, No. CV12-0234-PHX-NVW, 2013 WL
 17 12098786, at *1 (D. Ariz. June 20, 2013) (quoting *Regal Knitwear Co. v. N.L.R.B.*, 324

18 ³ Home Skinovations argues that PBL misstates the text of Home Skinovations’ motion
 19 by stating that Home Skinovations “only ‘imported a handful of samples’” because Home
 20 Skinovations did not use the word “only” in its motion. (MFL Resp. (Dkt. # 36) at 3 (quoting
 21 Surreply at 1, 2, 3).) However, the court also interprets Home Skinovations’s statement to mean
 22 that it had only imported a handful of samples and that its redesigned brush was not yet available
 to consumers in the United States. (*See* MFC at 10 (“Home Skinovations has imported a handful
 of samples of its redesigned Silk’n Pure product to the U.S. for analysis by its counsel and is
 planning to imminently introduce the product commercially into the U.S. market.”).) The court
 warns counsel for Home Skinovations that counsel risks losing the court’s confidence when they
 parse language so sharply.

1 U.S. 9, 15 (1945)) (second alteration in original). “As a result, courts are always free . . .
2 to clarify inexplicit injunctions in order to avoid unwitting contempts.” *Id.* (citing
3 *Hendrix*, 686 F.2d at 200).

4 Home Skinovations seeks a declaration from the court that the new Silk’n Pure
5 brush is not “substantially similar” to or a “colorable imitation” of the Silk’n Sonic or the
6 BellaSonicCleanPlus and that the Silk’n Pure brush does not infringe the ’691 Patent or
7 violate the permanent injunction. (*See* PI at 1; MTC at 1-2.) Although the court has the
8 discretion to clarify an injunction and “should provide clarification of any ambiguous
9 language that could cause unwitting contempts,” *Cornucopia*, 2013 WL 12098786, at *2,
10 such clarification is unwarranted here. First, Home Skinovations has not pointed to any
11 language in the permanent injunction that is ambiguous or needs clarification, and the
12 court notes that Home Skinovations participated in jointly drafting the permanent
13 injunction with PBL. (*See* Joint Mot. for PI.) Clarification is unnecessary because Home
14 Skinovations has failed to demonstrate that the injunction is unclear.

15 Instead of clarification, Home Skinovations seeks a declaration that the Silk’n
16 Pure brush does not infringe the ’691 Patent or violate the permanent injunction. Such a
17 declaration would require the court to carefully evaluate the redesigned brush. “That
18 kind of careful evaluation [comparing product design] should not be performed under the
19 guise of clarifying an injunction that is already clear.” *Cornucopia*, 2013 WL 12098786,
20 at *2. Indeed, non-infringement motions are dispositive motions that should be advanced
21 based on a fully developed record. *See Etagz, Inc. v. Quicksilver, Inc.*, No. SACV
22 10-0300, 2012 WL 2135497, at *3 (C.D. Cal. June 11, 2012) (denying a summary

1 judgment motion as “premature,” and noting that “[n]umerous courts have held that the
2 inquiry of whether two claims are identical should not occur until after formal claim
3 construction”); *Stratasys, Inc. v. Microboards Tech., LLC*, No. 13-3228 (DWF/TNL),
4 2014 WL 5438396, at *2 (D. Minn. Oct. 22, 2014) (denying as premature the defendant’s
5 motion for summary judgment on the issue of infringement filed prior to claim
6 construction proceedings). Although Home Skinovations submits evidence in support of
7 its position that Silk’n Pure brush does not operate “bi-directionally” (*see, e.g.*, Levi
8 Decl. (Dkt. # 21-2)), the court finds that the present record falls short of what is
9 ordinarily required when considering whether a device like the Silk’n Pure brush
10 infringes a patent. The court agrees with PBL that Home Skinovations’s “motion for
11 clarification” of the permanent injunction is a maladroit vehicle to drive the issue of
12 non-infringement to resolution.

13 If, as Home Skinovations initially averred, the product is not yet commercially
14 available in the United States (*see* MTC at 10), then judicial economy is not served by
15 resolving the issues presented in the motion at this time. If Home Skinovations “has not
16 yet ‘enter[ed] upon transactions which raise doubts as to the applicability of the
17 injunction,’” then it cannot “be held in contempt ‘until after a judicial hearing’ in which
18 the Court could determine whether a new design violates the . . . injunction ‘on a concrete
19 set of facts.’” *See Cornucopia*, 2013 WL 12098786, at *2 (quoting *Regal Knitwear*, 324
20 U.S. at 15-16) (alterations in original). Yet, there are a number of contingencies that
21 would obviate the need for such a hearing. First, PBL may simply decide not to bring a
22 motion for contempt under the permanent injunction. Alternatively, PBL may determine

1 that the redesigned brush infringes its intellectual property in a way that does not violate
2 the injunction. Indeed, PBL might choose to proceed against the new design in an
3 entirely separate infringement proceeding. Further, the court might determine, due to the
4 complexities of infringement analysis, that a contempt proceeding is not an appropriate
5 forum for deciding the infringement issue and that the matter should be resolved in a
6 separate infringement action. *See Additive Controls & Measurement Sys. v. Flowdata,*
7 *Inc.*, 154 F.3d 1345, 1349 (Fed. Cir. 1998) (citing *KSM Fastening Sys. v. H.A. Jones Co.*,
8 776 F.2d 1522, 1530-32 (Fed. Cir. 1985) (“That decision turns on a comparison between
9 the original infringing product and the redesigned device. If the differences are such that
10 ‘substantial open issues’ of infringement are raised by the new device, then contempt
11 proceedings are inappropriate.”)). Any of these events would render an in-depth analysis
12 of the new product’s design superfluous at this stage.

13 On the other hand, if the redesigned brush is already commercially available in
14 the United States, as Home Skinovations represents in its reply memorandum (*see* MTC
15 Reply at 3), then Home Skinovations’s motion is moot. Although a party “always has
16 the right to ask the court . . . whether [an injunction] applies to conduct in which the
17 person proposes to engage,” *Matter of Hendrix*, 986 F.2d at 200, Home Skinovations
18 would no longer be seeking “clarification” of the permanent injunction to advise
19 whether hypothetical future conduct would violate the permanent injunction. Rather,
20 Home Skinovations appears to have already engaged in the potentially wrongful
21 conduct. Thus, Home Skinovations does not seek to “avoid unwitting contempts,”
22 *Cornucopia*, 2013 WL 12098786, at *1 (citing *Hendrix*, 686 F.2d at 200), but rather

1 seeks a declaration from the court that its past conduct is not in violation of the
2 permanent injunction. The court declines to resolve the infringement issues presented
3 under the guise of a motion for clarification to “avoid unwitting contempts” when
4 Home Skinovations has failed to demonstrate that the injunction is ambiguous and has
5 apparently already engaged in the conduct at issue.

6 **IV. CONCLUSION**

7 Based on the foregoing analysis, the court DENIES Home Skinovations’s motion
8 for clarification of the permanent injunction (Dkt. # 21). In addition, because the court
9 resolved Home Skinovations’ motion in PBL’s favor without resort to the additional
10 information PBL sought to provide, the court DENIES as moot PBL’s motion for leave to
11 provide new information (Dkt. # 35).

12 Dated this 30th day of March, 2017.

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15 JAMES L. ROBART
16 United States District Judge
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